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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,714	09/29/2003	Frank J. Criscione II	5007756-82	4540

21129 7590 09/13/2005  
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KANSAS CITY, MO 64106-2140

EXAMINER

DEUBLE, MARK A

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/674,714	CRISCIONE ET AL.	
	Examiner	Art Unit	
	Mark A. Deuble	3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 27 and 28 is/are pending in the application.  
     4a) Of the above claim(s) 4-11 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/22/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

*AR*

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of invention I and species A in category 1, claims 1-3 and 27, in the reply filed on July 15, 2005 is acknowledged. While applicant does not appear to traverse the restriction requirement between inventions I and II because all claims directed to invention II were cancelled, the applicant traverses the species requirement. The traversal is on the ground(s) that searching the six species of category A would not be a serious burden on the examiner because the six species are members of a Markush group as discussed in MPEP § 803.02. This is not found persuasive because the different species are claimed in separate independent claims rather than in a single claim as a plurality of alternatively usable members as in a typical Markush claim. Furthermore, even if the different species were claimed alternatively in a single claim, it would not result in a proper Markush claim. In most cases, a Markush type claim includes an alternative recitation of the members of the Markush group that share a common utility and share a substantial structural feature disclosed as being essential to that utility because there is not appropriate or true generic language. Here, while the six claimed species share a common utility, namely gripping articles, they do so with different structural features and therefore are not appropriate for a Markush type claim. Finally, it should be noted that if the applicant wished to traverse on the ground that the species are not patentably distinct, the applicant should have admitted (or submitted evidence showing) that the species are obvious variants of each other. In the absence of such an admission or evidence the claims will be treated as patentably distinct and the election of species requirement will be maintained. On the other

hand, if the applicant makes such an admission (or submits such evidence), the admission (or evidence) may be used in a rejection under 35 U.S.C. 103(a) of the non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 4-11, and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 15, 2005.

### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the frame, the support mounted on the frame, and the drive means for moving the movable member of the third means for picking up objects must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Lines 9-13 recite "third means for picking up objects from the first means and depositing the objects at the second means, said third means including a movable member, and a support mounted o the frame; means supporting the member of the frame for movement relative to the first and second mean." This language renders the scope of the claims impossible to ascertain because it is unclear if the "support mounted on the frame" and the "means supporting the member on the frame" are separate structural element of the same structural element referred to with a slightly different label. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Connell (U.S. Patent No. 5,275,082).

Connell shows an apparatus which transfers objects between first means 12 and second means 60 mounted on a frame for holding and moving a plurality of objects. A third means 30 picks up objects from the first means and transfers them to the second means with a movable member 20 and a support 32 mounted on the frame via an axis 40 connected to a drive means for moving the member. Object pick up devices 22 are mounted on the movable member with suction grippers 24 protruding therefrom that they operate to pick up and drop off objects. Thus Connell shows all the structure required by claims 1-2 and 27.

8. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Wurgler (U.S. patent No. 5,419,427).

Wurgler shows an article pick up device 20 for use in transferring objects from a first location to a second location. The apparatus includes an array of object pick up devices 22 having a gripper 89 or 160 protruding from the object pick up device for engagement with objects. Thus Wurgler shows all the structure required by claim 27.

9. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Bowler et al. (U.S. patent No. 4,927,205).

Bowler et al. shows an article pick up device 20 for use in transferring objects from a first location to a second location. The apparatus includes an array of object pick up devices 26 having a gripper 77 protruding from the object pick up device for engagement with objects. Thus Bowler et al. shows all the structure required by claim 27.

***Claim Rejections - 35 USC § 103***

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wurgler.

Wurgler shows an apparatus 20 for transferring objects from a first location to a second location. The apparatus includes a frame 39 and a plurality of article holding devices 22 that form a third means for picking up objects at a first location and transporting them to a second location. The article holding device forming the third means includes a movable member 46 and a support means 21, 28 for supporting the movable member on the frame for movement relative to the first and second locations. A drive means (not shown) moves the moving member through the support means. An article pick up device 160 having a gripper formed by a piercing probe including an expandable needle 168 may be mounted on the movable member so that it protrudes therefrom. The pick up device is operable to pick up an object at a first location, transport the object to a second location, and release the object thereby allowing the object to be placed at a second location. Thus Wurgler shows all the structure required by claims 1-4 except for the first means for holding a plurality of objects and the second means for moving objects away from the first means. However, it should be noted that the transfer device of Wurgler is intended to be used for holding and conveying bottles through a coating operation which would make up only step in their movement through a bottling plant. Therefore it would have been obvious to use the apparatus of Wurgler to pick up articles from a first means that conveys articles to and holds articles at a first location and to release articles at a second means that would move objects away

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from the first means. When this is done, Wurgler would show all the structure required by claims 1-4.

12. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowler et al..

Bowler et al. shows an apparatus 20 for transferring objects from a first location to a second location. The apparatus includes a frame 48 and a plurality of article holding devices 26 that form a third means for picking up objects at a first location and transporting them to a second location. The article holding device forming the third means includes a movable member 56 and a support means 35, 38 for supporting the movable member on the frame for movement relative to the first and second locations. A drive means (not shown) moves the moving member through the support means. An article pick up device having a gripper formed by a piercing probe 74 including an expandable needle 76 may be mounted on the movable member so that it protrudes therefrom. The pick up device is operable to pick up an object at a first location, transport the object to a second location, and release the object thereby allowing the object to be placed at a second location. Thus Bowler et al. shows all the structure required by claims 1-4 except for the first means for holding a plurality of objects and the second means for moving objects away from the first means. However, it should be noted that the transfer device of Butler is intended to be used for holding and conveying bottles through a coating operation which would make up only step in their movement through a bottling plant. Therefore it would have been obvious to use the apparatus of Butler et al. to pick up articles from a first means that conveys articles to and holds articles at a first location and to release articles at a second means that would move objects away from the first means. When this is done, Butler et al. would show all the structure required by claims 1-4.



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13. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connell in view of Bowler et al. or Wurgler.

Connell shows generally all the structure required by the claims except for the gripper comprising a piercing probe with an expandable needle. However, both Bowler et al. and Wurgler teach that grippers may advantageously be formed by piercing probes with expandable needles. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the grippers of Connell with the grippers of Bowler et al or Wurgler. When this is done, the resulting apparatus would have all the structure required by claims 3-4.

#### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cooper and Japanese document number 2004-74317 show types of gripper devices that are similar to some of the species disclosed in the present application.

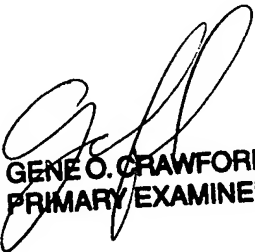
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Deuble whose telephone number is (571) 272-6912. The examiner can normally be reached on Monday through Friday except for alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

md



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PRIMARY EXAMINER